

REMARKS

This paper is filed in response to the office action dated July 31, 2008. In that office action, the specification is objected to for informalities, claims 7 and 8 are objected to as being in improper dependent form, claims 1-5 are rejected in view of prior art, and claim 6 is objected to as being dependent on a rejected claim. In light of the foregoing amendments and following remarks, applicants respectfully submit that the pending claims are in condition for allowance and respectfully solicit same.

Objection to the Specification

In the outstanding office action, the Examiner objects to the abstract for referring back to other portions of the specification by incorporating reference numbers to various drawings. In response, applicants have amended the abstract to be a stand-alone encapsulation of the invention without referring to other portions of the specification. Accordingly, applicants respectfully submit that the objection to the abstract should be withdrawn.

Claim Objections

Claims 7 and 8 are objected to as being dependent on other multiple dependent claims. In response, claims 2-4 have been canceled and each of the remaining dependent claims, i.e. claims 5-8, is now dependent on a single independent claim. As the pending claims are now in proper form, applicants respectfully submit that the objection to claims 7 and 8 should be withdrawn.

Claim Rejections – 35 U.S.C. §103

In the office action, claims 1-5 stand rejected as being obvious over International Patent Application No. WO2001/88835 (“Shapiro”) in view of European Patent Application No. EP 0 348 182 (“Kato”). Applicants respectfully disagree.

To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered” and MPEP §2141.02 requires consideration of the “[claimed] invention and prior art as a whole.” Further, the Board of Patent Appeals and Interferences recently confirmed that a proper, post-KSR obviousness determination still requires the Office to make “a searching comparison of the claimed invention – including all its

limitations – with the teaching of the prior art.” See, *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Applicants believe that each of the pending claims includes one or more elements that are not disclosed by the combination of Shapiro and Kato noted above, thereby overcoming the aforementioned rejection, as discussed more specifically below.

Independent claim 1, as well as claims 5-8 dependent thereon, specifies an optical device for forming an image of fingerprints having an optical plate 1, at least one light source 7, a focusing objective 9 and a diaphragm 10. The optical plate 1 includes a first main face 2, a first lateral face 4 arranged as a convergent mirror, and a second lateral face 5 opposite the first lateral face 4 and forming an exit face 5 of the optical plate 1. The diaphragm 10 is disposed between the exit face 5 and the focusing objective 9 and includes an aperture 11. The angle of incidence of light rays on the first main face 2, inside the optical plate 1, is increased and the thickness of the optical plate 1 can be reduced. As currently amended, claim 1 requires the exit face 5 to define an angle greater than 90° with the first main face 2. Amended claim 1 further requires the plane of the first main face 2 to define an angle between 2° and 25° with a plane perpendicular to the exit face 5 and to intersect the diaphragm 10 under and close to the aperture 11 thereof, such that a major part of stray light transmitted from the exit face 5 is intercepted by the diaphragm 10 underneath its aperture 11. Support for the same is found in paragraphs [0037]-[0038] of the present application, U.S. Publication No. 2007/0014524. No new matter has been added.

The Examiner asserts that all of the aforementioned limitations are either disclosed or rendered obvious by the combination of Shapiro and Kato. Applicants respectfully disagree. Shapiro discloses a fingerprint imaging device having an optical plate 2, an objective 3, a finger field 20, a converging mirror 21, a lateral surface 22 and an aperture stop 30. In contrast with the present application, the finger field 20 of Shapiro forms a 90° angle with the lateral surface 22; the plane of the finger field 20 is parallel with the plane perpendicular to the lateral surface 22; and the plane of the finger field 20 does not intersect any portion of the aperture stop 30. Kato discloses finger detection device having a light transmission base 7, a lower surface 7-1, an upper surface 7-2, a focusing lens 11, a diaphragm 15 and an aperture 15a. The Examiner thus relies upon Kato to supply Shapiro with an angled exit face which forms an angle greater than 90° with the upper surface 7-2.

However, Kato fails to supply Shapiro with a first main face which defines a plane having an angle between 2° and 25° with a plane perpendicular to its exit face, and intersecting a diaphragm under an aperture thereof. In particular, the upper surface 7-2 of Kato defines a plane forming an angle that is apparently greater than 45° with a plane perpendicular to its exit face. Furthermore, the plane of the upper surface 7-2 does not intersect any portion of the diaphragm 15 of Kato. As the purported combination of Shapiro and Kato fails to disclose all of the limitations required by amended claim 1, as well as claims 5-8 dependent thereon, the obviousness rejection of the pending claims must be withdrawn.

CONCLUSION

In light of the foregoing, applicants respectfully submit that each of the currently pending claims, i.e. claims 1 and 5-8 are in condition for allowance and respectfully solicit the same. If a telephone call would expedite prosecution of the subject application, the Examiner is invited to call the undersigned agent. The undersigned verifies that he is authorized to act on behalf of the assignee of the present application.

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Respectfully submitted,

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